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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,539	07/22/2002	Heinrich Gers-Barlag	Beiersdorf 759-HCL	6360
7590 04/07/2004			EXAMINER	
Norris McLaughlin & Marcus 30th Floor 220 East 42nd Street New York, NY 10017			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,539

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on December 29, 2003. Claim rejection made under 35 U.S.C. § 103 as indicated in the previous Office action dated October 2, 2003 is maintained for the reasons of the record. Claim objection as indicated in the same Office action is withdrawn in view of the claim amendment made by applicants. Obvious double patenting rejection is withdrawn in view of applicants' remarks. New rejections are made to address the new claims, claims 13-20. Claims 1-5 and 7-20 are pending.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag (WO 98/42300) in view of Msika (US 5939054) and Plaschke (US 6409996 B1).

Gers-Barlag teaches an emulsifier-free oil-in-water cosmetic composition comprising an oil phase, a water phase, and one or more types of micronized, inorganic metal oxides having amphiphilic properties, and other cosmetic additives. See abstract.

Gers-Barlag fails to teach phyllosilicate and flavones, flavonoids, or flavanones.

Msika teaches water-in-oil sunscreens comprising titanium and/or zinc oxide particles. The reference teaches that no additional emulsifiers are added. See col. 2, lines 1 -9. The reference teaches using a modified phyllosilicate, montmorillonites of the bentone for stabilizing the composition, and shows a formulation

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comprising 0.1-5 % by weight of Bentone 38. See col. 3, lines 49 –55; col. 4, lines 24 – 30; col. 9, line 55 – col. 10, line 14. See instant claims 4 and 11. 11The example shown in col. 8, lines 50 – 66 shows using alpha-tocopherol acetate, an antioxidant, by 0.5 % by weight, and further teaches that flavonoids also can be used as an antioxidant. See col. 5, lines 41 – 46. See instant claims 5 and 12. The reference teaches using titanium dioxide treated with alkylsilane or aluminum hydroxide and stearic acid. See instant claims 2, lines 1 – 37. The reference teaches the mean particle size of the titanium oxide particle is 20 nm, and the zinc oxide particles, 60 nm. See col. 2, lines 30 – 37.

Msika fail to provide specific motivation to select flavonoids as the antioxidant.

Plaschke teaches a flavonoid-containing sunscreen composition. See abstract. The invention is said to provide optimized UV-absorption profile. See col. 2, line 21 – col. 4, line 62.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Barlag by adding the phyllosilicate as motivated by Msika because of an expectation of successfully producing a stable emulsion. The skilled artisan would have been motivated to further add flavonoid as motivated by Plaschke because of an expectation of successfully producing a cosmetic composition with good UV protection.

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Claims 13–20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag, Msika, and Plaschke as applie to claims 1-5 and 7-12 as above, and further in view of Suzuki et al. (US 5145781).

The combined references fail to teach the flavone as recited in claims 13-20.

Suzuki teaches that alpha-glycosyl rutin has good water-solubility, resistance to light and stability to intact rutin. See abstract. The reference teaches “alpha-glycosyl rutin is favorably usable as a yellowing agent, antioxidant, stabilizer, fading-preventing agent, quality-improving agent, preventive, remedy, uv-absorbent, and deterioration-preventing agent in . . . cosmetics including skin-refining agent and skin-whitening agent”. See abstract. Examples B-9, B-13, B-14. and B-15 shows examples of topical compositions comprising alpha-glycosyl rutin. Example B-14 particularlry teaches an emulsion.

Given the teaching of using flavone in cosmetic composition in the combined references, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Suzuki and have been motivated to use alpha-glycosyl rutin because of the expectation of successfully producing a cosmetic composition with UV protection, skin-refining and skin-whitening effects and enhanced stability.

Response to Arguments

Applicant's arguments filed December 29, 2003 have been fully considered but they are not persuasive.

Applicants argue that the primary reference, Gers-Barlag (WO 98/42300), fails to teach water-in-oil emulsion. Examiner notes that formulating a water-in-oil emulsion from an oil-in-water emulsion is an obvious variation, given the generally known concept that whether an emulsion is water-in-oil or oil-in-water depends on the choice of the emulsifiers used. The variation of one type of emulsion to another is viewed even more obvious in this case because no emulsifier is used in the Gers-Barlag and the present invention. Examiner also notes that water-in-oil emulsion is taught by Msika.

Applicants' argument that the phyllosilicate taught in Gers-Barlag somehow does not possess the properties claimed by the applicants is unpersuasive. The property of a compound is inseparable from the compound. Also, applicants are not claiming the properties of phyllosilicate but simply claiming a composition comprising the compound, which is well known in the art according to the cited references.

Applicants further argue that "the number of permutations of possible embodiments of their invention is virtually limitless" because Gers-Barlag, Msika, and Plascke teach compositions which comprise multiple components. In response, examiner asserts that the rejection is proper because combining the specific components as recited by applicants is supported by the objective teachings in the prior arts: the reference clearly provides specific motivation to use phyllosilicate or flavanoids. Examiner believes that a prima facie obviousness has been established in this case.

Applicants also argue that "teaching away" is not addressed in the prior art. Examiner finds the argument unpersuasive because none of the references indicate any negative teaching in combining the teachings therein. See MPEP § 2145 (D).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina C. Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER